

REMARKS

All the claims examined on the merits in this application, have been rejected on formal and/or substantive grounds. Applicants have amended their claims and respectfully submit that all the claims examined on the merits in this application are patentable over the rejection of record.

Turning first to the sole formal ground of rejection imposed in the outstanding Official Action, Claims 27-29 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, Claims 27-29 recite "the methylsiloxane moiety." The Official Action argues that the disclosure of Claim 26, from which each of these ultimately depend, does not provide sufficient antecedent basis for this recitation.

Applicants have amended Claims 27-29 to supplement the recitation originally presented therein in those claims. That is, the term "methylsiloxane moiety" has been replaced with --methylsiloxane moieties (m and n)--. Applicants submit that not only is this recitation fully supported by the originally filed specification at page 8, lines 3-6 but, in addition, that recitation makes it abundantly clear that the methylsiloxane moieties under consideration are the groups bracketed by subscripts m and n in the formula of Claim 26.

Applicants submit that this amendment to Claims 27-29 introduce sufficient antecedent basis so that these claims are not subject to rejection under 35 U.S.C. §112, second paragraph. Reconsideration and removal of this ground of rejection is, therefore, deemed appropriate. Such action is respectfully urged.

Several substantive grounds of rejection have been imposed in the outstanding Official Action. The first of these rejections, a new rejection, is directed to Claims 1, 2 and 6. Claims 1, 2 and 6 stand rejected, under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,792,825 to Karrer et al. The Official Action argues that Karrer et al. discloses a composition comprising a polyorganosiloxane and an admixed sterically hindered amine light stabilizer (HALS) wherein the polyorganosiloxane is free from alternating cyclic hydrocarbon residues.

Applicants respectfully submit that it is axiomatic that a reference applied as being anticipatory, under 35 U.S.C. §102(b), must disclose each and every limitation of the claim which is allegedly anticipated by the reference. Clearly, Karrer et al. is far removed from Claims 1, 2 and 6, which the Official Action alleges are not novel over the disclosure of Karrer et al.

Claims 1, 2 and 6 are directed to a composition comprising a polyorganosiloxane and an admixed sterically hindered amine light stabilizer (HALS). That is, two components are present in the claimed composition. Clearly, Karrer et al. does not disclose a composition comprising a polyorganosiloxane and a HALS. The disclosure of Karrer et al. is directed to a silicone compound which incorporates therein sterically hindered cyclic amine functional groups. It is a basic principle of chemical patent law that a composition comprising at least two components is clearly novel over a compound which, of course, represents one component.

Stated differently, the disclosure of Karrer et al. describes a polyorganosiloxane. However, that disclosure does not disclose and, indeed, teaches away from a composition which includes a polyorganosiloxane and a HALS. The reason why Karrer et al. teaches

away from the claimed composition is that the polyorganosiloxane described in Karrer et al. is alleged to possess properties that are provided by the HALS component of the composition of Claims 1, 2 and 6. The Karrer et al. compound, including as it does hindered cyclic amine functionality, would not suggest to one skilled in the art a composition which includes a separate hindered amine compound.

It is noted in passing that the teaching of Karrer et al. does not make obvious any of Claims 1, 2 and 6. The synthesis of a new compound requires extensive costs and difficulties that are far simplified by the combination of a commercially available HALS and the specifically desired polyorganosiloxane.

It should also be appreciated that the class of polyorganosiloxane that can be combined with strictly hindered cyclic amine groups in Karrer et al. is limited to polyorganosiloxanes having the formula described therein. No such restriction is imposed on the polyorganosiloxane of the composition of Claim 1.

It is unnecessary to address the specific grounds imposed in support of the rejection of Claims 1, 2 and 6. The Karrer et al. polyorganosiloxane compounds, which contains sterically hindered cyclic amine functional groups, does not so much as describe a composition which includes a HALS. As stated above, this is to be expected insofar as the title of the Karrer et al. patent is silicone compounds containing sterically hindered cyclic amine functional groups. Such a compound is at odds with the claimed composition of the present application, which includes separate polyorganosiloxane and HALS components.

The second new ground of rejection is directed to Claims 3-5, 7-25 and 30-32. These claims stand rejected, under 35 U.S.C. §103(a), as being unpatentable over Karrer et al.

Many of the claims subject to rejection under 35 U.S.C. §103(a) recite concentration ratios of various components of the claimed composition. Indeed, the Official Action states that Claims 3-5, 7-9, 15-17 and 20-22 recite mole percentages, which the Official Action admits are not disclosed in Karrer et al. Thus, insofar as Karrer et al. does not disclose a composition which includes a polyorganosiloxane and a HALS, it is apparent that with Claims 3-5, 7-25 and 30-32 directed as those claims are to a composition, which includes those two components, are not made obvious by the teaching of Karrer et al.

Claims 18 and 19 are directed to a vinylsiloxane fluid. Such a fluid is not advanced in the Official Action as being employed in the compound of Karrer et al. Similarly, the organohydrogensiloxane crosslinker of Claims 23-25 are not alleged, in the Official Action, as being disclosed by Karrer et al. Finally, Claims 30-32, directed to the concentration of the HALS, is totally outside the teaching of Karrer et al.

Three grounds of rejection, imposed in the first Official Action, have been retained in the outstanding Official Action. Each of these grounds of rejection are imposed under 35 U.S.C. §103(a). The first of these is directed to Claims 1-17, 20-25 and 30-32. These claims stand rejected, under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent 5,013,800 to Inoue et al. in view of U.S. Patent No. 5,350,786 to Costanzi et al.

The Official Action submits that Inoue et al. discloses an original polyorganosiloxane coating composition to which ultraviolet absorbers and aging retarders are added. The Official Action states, without any reference support, that HALS are aging retarders added to polymeric compositions exposed to UV light to protect the polymer from degradation. The Official Action applies the secondary Costanzi et al. reference for its disclosure of HALS added to a reaction mixture of α -olefins to form a polymeric composition.

Applicants have previously argued that the teaching of the utilization of a HALS in a polyolefin composition does not render unpatentable, under 35 U.S.C. §103(a), a claim directed to a HALS in a silicone composition.

Even if the Official Action assertion that there is no disclosure in Costanzi et al. that teaches or discloses an effective temperature range for the use of the HALS, that observation is irrelevant insofar as the disclosure in Costanzi et al. is totally devoid of any disclosure of utilizing a HALS in a polyorganosiloxane composition. To overcome this critical deficiency the Official Action asserts the teaching of Karrer et al., which discloses a composition employing a polyorganosiloxane and HALS.

The above remarks, which discuss the Karrer et al. disclosure, emphasize that Karrer et al. is not directed to a composition which includes a polyorganosiloxane and a HALS. Rather, the compound disclosed in Karrer et al. is a polyorganosiloxane, which includes sterically hindered cyclic amine functional groups. Such a product is a compound, rather than a composition, and is totally distinguished therefrom. Thus, none of the remarks made in the outstanding Official Action, in responding to applicants' remarks, made in the Amendment filed February 5, 2003, can be given any weight in supporting this ground of rejection since Karrer et al. does not so much as teach or even suggest a composition.

The above remarks, which establish the patentability of the composition claims examined on the merits in this application, lead applicants to respectfully solicit reconsideration and removal of the substantive grounds imposed in the outstanding Official Action.

It is emphasized that Claim 2 has been amended to overcome the objection lodged in the outstanding Official Action, the misspelling of the word "polyorganosiloxane." In addition, Claim 11 has been amended to recite proper Markush group language.

The above amendment and remarks establish the patentable nature of all the claims examined on the merits in this application. Notice of Allowance and passage to issue of these claims, Claims 1-32, is, therefore, respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marvin Bressler", with a long horizontal flourish extending to the right.

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